

## REMARKS

Claims 1-12 and 14-17 are pending in the above-referenced application. Additionally, claims 1-12 and 14-17 were rejected by the Examiner under 35 U.S.C. §103 under Dedrick (U.S. Patent No. 5,724,521) in further view of Angles et al. (U.S. Patent No. 6,385,592 B1). Each of the Examiner's rejections are considered and answered with regard to the above amendments and the responsive comments below. An appendix showing the amendments to the claimed invention is included following these remarks.

### Claim Rejections - 35 U.S.C. §103(a)

On page 3 of the Final Office Action, the Examiner rejected claims 1-12 and 14-17 under 35 U.S.C. §103(a) as being unpatentable over Dedrick in further view of Angles et al.

Applicants request the Examiner to consider and enter the above amendments and following remarks as traversing the previous rejections and placing the claims in condition for allowance.

#### Claim 1

In the Final Office Action, the Examiner rejected claim 1 stating that Dedrick discloses "...renting out a marketing object container to a first party, wherein the marketing object container is presented in a web page associated with a second party (col. 4 line 3 – col. 5 Line 4) in the context of presenting advertisers' advertisements to users over the system for a fee; selecting an attribute to be associated with the marketing object container, wherein the first party associates the attribute with the marketing object container (col. 4 lines 16-35; col 5 lines 5-53); and sending the selected attribute to be associated with the marketing object container (col. 4 lines 16-48; col. 5 lines 5-53), in the context of associating the chosen attributes with the identified advertisements." (paragraphs 1-3, page 3 of the Office Action). The Examiner stated

that "Dedrick does not specifically disclose sending the selected attribute to be automatically associated with the marketing object container." (paragraph 4, page 3 of the Office Action). However, the Examiner in the Advisory Action mailed on February 10, 2003, also stated that Dedrick disclosed "... "automatically" associating the selected marketing attribute with the marketing object container." Applicants request the Examiner to provide clarification as to the rejection of claim 1 in regard to these opposing statements.

Applicants submit that, in light of the Examiner's stated rejection, that the claimed invention is not obvious in light of the cited references. The claimed invention is not obvious in light of the references because neither discloses the elements of "...sending the selected marketing attribute to be *automatically associated*" or "*a marketing attribute*." To establish obviousness, three requirements must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP §706.02(j). Here, the Examiner's rejection has failed to show that the "automatic association of a marketing attribute with a marketing object container" and a "marketing attribute," as claimed and defined by the Applicants' specification, is taught by the cited references. Thus, all of the Applicants' claim limitations are neither taught nor suggested thus failing to establish a case of obviousness under MPEP §706.02(j).

As to the first element of the claimed invention, Applicants submit that the cited references, individually or combined, do not disclose "...sending the selected marketing attribute to be *automatically associated*." Specifically, the claimed invention of "sending the selected

marketing attribute to be *automatically associated* with the marketing object container” is not disclosed by Dedrick and, further, is also non-obvious in view of Angles et al.

The Examiner stated that HTML, the HyperText Markup Language, is a “...standard coding convention and set of codes for attaching presentation and linking attributes to information content within documents. (HTML 2.0) is currently the primary standard used for generating Web documents. During a document authoring stage, the HTML codes (referred to as “tags”) are embedded within the informational content of the document.” (paragraph 4, page 10, Office Action). However, Applicants submit that HTML tags are not *automatically* associated, but are discretely embedded into content in order to create and display web pages. (Angles et al., col. 18, lines 24-37). Further, the HTML codes of Angles et al. are placed by a content provider within the content to be displayed, suggesting a manual and non-automatic association. (Angles et al., col. 18, lines 35-36). Claim 1 clearly recites *automatic association* of a marketing attribute, which is distinguishable from the implicitly manual use of HTML, as described by Angles et al. Thus, automatic association of a marketing attribute is not obvious in light of the cited references.

Applicants also submit that a “marketing attribute” is also not obvious under the cited references, either individually or in combination. According to the Applicants’ specification, marketing attributes include “...marketing campaigns and features in merchandising marketing, scheduling of objects to be displayed, behavior-driven targeting of marketing material to a user, and profile driven targeting of the marketing material to a user.” (Page 16, Specification). The Examiner rejected claim 1 stating that Dedrick discloses “embedded variables within electronic information.” (col. 4, lines 16-35). However, the embedded consumer variables of Dedrick are patentably distinct from the claimed invention.

Dedrick uses “embedded consumer variables” with a particular advertisement to determine performance, metering, or traffic characteristics. (*see*, e.g., col. 5, lines 29-53). Embedded consumer variables are patentably distinct from marketing attributes, which describe marketing campaigns or features. (*see*, e.g., Page 16-17, Specification). In Dedrick, a consumer variable is used as a parameter or criteria to determine performance characteristics such as the amount of traffic which is determinative of a fee. (col. 5, lines 36-53). “The embedded consumer variables enable a client activity monitor and a consumption device to monitor consumer interaction with the electronic information based on the consumer’s interaction...” (col. 4, lines 18-22). Dedrick clearly shows that the embedded consumer variables are used to monitor consumer interaction with an advertisement.

In contrast, the claimed invention recites a “marketing attribute” which is associated with a marketing object container. “Examples of a marketing attribute include marketing campaigns and features in merchandising marketing, scheduling of objects to be displayed, behavior-driven targeting of marketing material to a user, and profile-driven targeting of the marketing material to a user.” (*see*, e.g., Page 16, Specification). Marketing attributes can describe, for example, what marketing objects can be received by a marketing object container, the relationship of a particular marketing object container to other marketing object containers, or the timing and priority of the display of marketing objects. (*see*, e.g., Page 15, Specification). Marketing attributes are not used to monitor consumer interaction with electronic information as disclosed by Dedrick.

Further, as mentioned previously, the Examiner rejected claim 1 stating that HTML is a “...standard coding convention and set of codes for attaching presentation and linking attributes to information content within documents.” (Paragraph 4, Page 10, Office Action). The HTML

linking attributes of Angles et al. are patentably distinguishable from the marketing attributes of the claimed invention. Applicants submit that a person having ordinary skill in the art at the time the invention was made would appreciate that “marketing attribute” as recited in claim 1 and illustrated in the Applicants’ specification, is patentably distinct from links used to generate, parse, or direct a user to particular web content. (see Angles et al., col. 6, lines 37-54). A hyperlink directing a web browser from one web page to another web page, for example, is not a marketing campaign or feature such as a daily promotion, content detail, cross sell, or up sell. (Pages 16-17, Specification). A person having ordinary skill in the art at the time the invention was made would readily understand that the “linking attributes” recited in Angles et al. are patentably distinct from the “marketing attributes” of claim 1. Thus, as the cited references do not disclose marketing attributes as defined by the Applicants’ specification, Applicants submit that claim 1 is not obvious.

For those reasons discussed above, Applicants submit that claim 1 is not obvious in light of the cited references and in condition for allowance. In addition, claims 2-5 depend from claim 1 and Applicants submit that claims 2-5 are also in condition for allowance for similar reasons as those stated above for claim 1. Further, as claims 5, 6, 9, 15, and 16 were amended for similar reasons as those stated above for claim 1, Applicants submit that these claims are also in condition for allowance. Finally, as claims 7-12, 14, and 17 depend from claims 6, 14, and 16, these claims are also in condition for allowance for the reasons stated above for claim 1.

### **CONCLUSION**

Based on the above amendments and remarks, Applicants respectfully request the entry of the above amendments and submit that, as amended, all pending claims are in condition for

allowance. Thus, the claims of the present application are believed to be allowable based on Applicants' above amendments and remarks. Upon consideration of the Request for Continued Examination submitted herewith and entry of the above amendments and remarks, Applicants submit that the application is in condition for allowance, and respectfully request the issuance of a Notice of Allowability.

If the Examiner has any questions or would like to discuss this case, he is invited to contact the Applicants' undersigned representative at the number given below.

Respectfully submitted,

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Date: March 18, 2003

By: \_\_\_\_\_



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## **APPENDIX: MARKED-UP VERSION OF CLAIMS 1, 5, 6, 9, 15, AND 16**

*Please amend claims 1, 5, 6, 9, 15, and 16 as follows:*

1. (Amended) A method of providing an electronic marketing presentation, comprising:  
  
renting out a marketing object container to a first party, wherein the marketing object container is presented in a web page associated with a second party;  
  
selecting, by the first party, a[n] marketing attribute[ to be associated with the marketing object container, wherein the first party associates the attribute with the marketing object container]; and  
  
sending the selected marketing attribute to be automatically associated with the marketing object container.
  
5. (Amended) The method of claim 1, further comprising renting out a second marketing object container to the first party, wherein the second marketing object container is presented in a second web page associated [by]with a third party, and wherein the selected marketing attribute is automatically associated with the second marketing object container.
  
6. (Amended) A method of providing an electronic marketing presentation, comprising:  
  
providing a marketing object container associated with a first party;  
  
associating the marketing object container with a website, wherein the website is associated with a second party; and  
  
automatically associating a[n] marketing attribute with the marketing object container[, wherein the first party associates the attribute with the marketing object container].

9. (Amended) The method of claim 8, wherein associating the marketing attribute with the marketing object container also automatically associates the marketing attribute with the second marketing object container.

15. (Amended) A system of providing an electronic marketing presentation, comprising:

a processor configured to provide a marketing object container associated with a first party; the processor also being configured to facilitate associating the marketing object container with a website, wherein the website is associated with a second party; and facilitating automatically associating a[n] marketing attribute with the marketing object container[, wherein the first party associates the attribute with the marketing object container]; and

a memory coupled with the processor, wherein the memory is configured to provide the processor with instructions.

16. (Amended) A computer program product for providing an electronic marketing presentation, comprising:

computer code providing a marketing object container associated with a first party;

computer code associating the marketing object container with a website, wherein the website is associated with a second party;

computer code automatically associating a[n] marketing attribute with the marketing object container[, wherein the first party associates the attribute with the marketing object container]; and

a computer readable medium that stores the computer codes.